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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,089	12/02/2003	David Byrne Reese	GCENP003	6003

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,089	Applicant(s) REESE ET AL.	
	Examiner Melvin H. Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/03/06 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. Applicant fails to amend or otherwise address the objection to the title. The objection thus remains.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's definition of "plurality of services") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant attempts to equate the added limitations to be regarding a plurality of applications, such that service 1 (i.e. auctioning) is of a different service than service 2 (i.e. web services or media downloads). This is a far narrower reading than is typical in the art.
4. Laster teaches a method and system wherein a single manager controls multiple providers to perform multiple, non-overlapping, potentially simultaneous auction sessions by utilizing multiple channels, wherein a user selects a channel and service, said services being further differentiated by the type of product being auctioned (i.e. service 1 = computers, service 2 = heavy equipment, and service 3 = furniture) (Para. 57).
5. In response to applicant's argument that neither Laster or Capiel teaches multiple applications, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

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invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The rejections of the independent claims are based on Laster in view of Capiel. Applicant, in its arguments, fails to challenge the combination, and further admits that Laster and Capiel teach different applications. Given the lack in the claims as to any interrelation of different services, and given the lack of any selection process between services or indication that either provider may provide both services, an argument may be made that the combination meets the narrower version as well.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4, 6, 10-14, 16, 17, 19, 20, 22, 25-29, 31, 32, 34, 35, 37, 39, 43-47, 49, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laster et al. (2001/0029478) in view of Capiel (6,449,634).

9. For claims 1, 19, 34, Laster teaches a method and system (abstract) for provisioning services (Paras. 1-10), the method comprising:

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- a. Providing a service manager system (Figs. 1-3) operable to mediate messages sent with respect to a plurality of services (Paras. 38-54) of a plurality of different providers (Fig. 2);
- b. Receiving a first offer pertaining to a first service (Para. 152) and a second offer pertaining to a second service that differs from the first service (Paras. 38-62), the first offer being provided by a first provider of the first service to which the first offer pertains (Paras. 236-353) and being transmitted from a first device to the service manager system (Paras. 55-57), the second offer being provided by a second provider of the second service to which the second offer pertains and being transmitted from a second device to the service manager system (Fig. 6);
- c. Receiving identifying information regarding one or more first invitees to be invited to access the first service of the first offer (Paras. 161 – 188), the identifying information regarding the one or more first invitees being transmitted from the first device to the service manager system (Paras. 206-217), and receiving identifying information regarding one or more second invitees to be invited to access the second service of the second offer, the identifying information regarding the one or more second invitees being transmitted from the second device to the service manager system (Paras. 206-217);
- d. In response to receipt of the first offer and the identifying information regarding the one or more first invitees (Para. 238), providing by the service manager system an invitation to each of the one or more first invitees to access the first service of the first

offer through the service manager system and based on the received identifying information regarding the one or more first invitees(Para. 152); and.

e. In response to receipt of the second offer and the identifying information regarding the one or more second invitees (Para. 238), providing by the service manager system an invitation to each of the one or more second invitees to access the second service of the second offer through the service manager system and based on the received identifying information regarding the one or more second invitees (Para. 152).

10. Laster does not expressly disclose the one or more invitees being transmitted from the first device to the service manager. Capiel teaches a method and system (abstract) of providing invitations (col. 1, line 1 – col. 2, line 25) from a provider (Fig. 1, #112) to an invitee (Fig. 1, #142) via a third-party proxy server (Fig. 1, #130-134), such that the third party acts as a middleman (col. 2, line 65 – col. 3, line 20), wherein the provider sends a customer list and service information to the proxy (col. 3, lines 20-30), wherein the proxy uses the information to create an invite (col. 3, lines 30-60). At the time the invention was made, one of ordinary skill in the art would have added Capiel's methods to Laster in order to improve targeted advertising by utilizing prior customer information (col. 1, lines 20-30), and further to improve targeted advertising by creating invites crafted for a particular user's tastes and hardware (col. 1, lines 40-60).

11. For claims 2, 20, 35, Laster teaches that the invitation is provided in the form of an email (Para. 152).

12. For claims 4, 22, 37, Laster teaches providing a unique URL address (Uniform Resource Locator) for each one or more invitees (Paras. 146-152), and providing the corresponding URL

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address in the each invitation to each invitee, wherein the URL address points to one or more web pages which allows the each invitee to register identifying information and accept terms of the offer (Para. 142).

13. For claims 6, 39, Laster teaches that the each invitation is provided by a provisioning service implemented on the service manager system (Para. 238).

14. For claims 7, 24, 40, Laster teaches storing the offer and its associated one or more invitees (Fig. 1, esp. Fig. 1, #10 and 14).

15. For claims 10, 25, 43, Laster teaches presenting a registration input form to a first invitee of the one or more invitees for the offer when the first invitee accesses the invitation (Paras. 161-180).

16. For claims 11, 26, 44, Laster teaches that the identifying information received for the first invitee is pre-filled into the presented registration form (Para. 185).

17. For claims 12, 27, 45, Laster teaches that the invitation to the each one or more invitees further allows the each one or more invitees to accept the invitation (Fig. 7, #130).

18. For claims 13, 28, 46, Laster teaches presenting an acceptance link to the first invitee when the invitee submits the registration form with identifying information (Paras. 183-186).

19. For claims 14, 29, 47, Laster teaches setting up permissions between the first invitee and the service when the first invitee registers and accepts the offer (Para. 181).

20. For claims 16, 31, 49, Laster teaches that the method further comprises:

- a. When the first invitee accepts the first offer, storing an indicator that the first invitee accepted the offer and the date of such acceptance (Para. 181);

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- b. When the first invitee does not accept the offer, storing an indicator that the first invitee did not accept the offer (Para. 188);
 - c. When the first invitee registers, storing an indicator regarding the registration and the date of such registration (Paras. 185 and 186); and
 - d. When the first invitee does not register, storing an indicator that the first invitee did not register (Paras. 185 and 186).
21. For claims 17, 32, 50, Laster teaches providing the indicator regarding the acceptance, the date of acceptance by the first invitee, and the indicator regarding registration to the provider queries regarding the first invitee or the offer (Paras. 188 and 189).
22. Claims 3, 5, 8, 9, 15, 18, 21, 23, 30, 33, 36, 38, 41, 42, 48, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laster and Capiel as applied to claims 1, 19 and 34 above, and further in view of Abendroth (2002/0087371).
23. For claims 3, 21, 36, Laster and Capiel do not expressly disclose that the invitation is provided in the form of a message or an FTP (file transfer protocol) drop. Abendroth teaches a method and system (abstract) of using a third party system to create and forward invitations between vendors and clients (Paras. 1-21) that fulfills this limitation (Para. 10). At the time the invention was made, one of ordinary skill in the art would add Abendroth's auction system to Laster's auction system in order to ensure integration between vendors and clients (Para. 9).
24. For claims 5, 23, 38, Lastier and Capiel do not expressly disclose that the unique URL address is provided to the provider by a provisioning service implemented on the service manager system, and wherein the provider sends the each invitation to each of the one or more

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invitees. Aberdroth teaches this limitation (Para. 66). At the time the invention was made, one of ordinary skill in the art would add Abendroth's auction system to Laster's auction system in order to ensure integration between vendors and clients (Para. 9).

25. For claims 8, 41, Lastier and Capiel do not expressly disclose that the offer and its associated one or more invitees are only stored when the provider is authorized to create the offer, and wherein the invitation is only provided to the one or more each invitees when the provider is authorized to create the offer. Abendroth teaches this limitation (Paras. 64-65). At the time the invention was made, one of ordinary skill in the art would have added Abendroth vendor authentication for security purposes (Para. 20).

26. For claims 9, 42, Lastier, Capiel and Abendroth do not expressly disclose sending an error message to the provider when the provider is not authorized to create the offer.

27. Examiner takes Official Notice (see MPEP § 2144.03) that "error message notifications" in a computer networking environment was well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art to use error messages for the purpose of notifying authorization problems to block intruders, and further to warn legitimate users of potential problems. Further, it increases user comprehension and acts as a convenient method of providing such information.

28. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234

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states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

29. For claims 18, 33, 51, Laster teaches that the registration form is presented to the first invitee by presenting an invitation page having a registration link (Figs. 5A and 5B), the method further comprising:

- a. Presenting an option link in the invitation page (Para. 142), wherein the option can be accessed by invitees which have already registered (Para. 144);
- b. Presenting an acceptance link to the first invitee when the invitee submits the registration form with identifying information (Figs. 6-9); and
- c. Presenting the acceptance link to the first invitee when the invitee selects the option link and the first invitee is already registered (Figs. 6-9).

30. For claims 15, 30, 48, Laster does not expressly disclose that permissions are not set up when the first invitee is not authorized to accept the offer. Abendroth teaches this limitation (Paras. 64-65). At the time the invention was made, one of ordinary skill in the art would have added Abendroth vendor authentication for security purposes (Para. 20).

Conclusion

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Melvin H Pollack

Examiner

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MHP

11 January 2007

A handwritten signature in black ink, appearing to read 'J. Cardone', with a long horizontal flourish extending to the right.

JASON CARDONE
SUPERVISORY PATENT EXAMINER